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EXAMINER

DIXON, THOMAS A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,722

Applicant(s)

MARTIN ET AL.

Examiner

Thomas A. Dixon

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 17 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 17 and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The request filed on 5/22/02 for Continued Examination (RCE) based on parent Application No. 09/863,722 is acceptable and an RCE has been established. An action on the RCE follows.
2. Examiner thanks applicant for the re-submission of the NPL and Foreign references and notes that original IDS box, received 12/17/02 has been located. Rejections based on consideration of the references follow.
3. The terminal disclaimer filed 4/25/03 is acceptable.

Response to Arguments

4. Applicant's arguments with respect to Kirkorian are convincing, the rejection is withdrawn.
5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the motivation is recognized by one of ordinary skill in the art based on the features taught by the prior art. Castille teaches the functionality of a Jukebox" and is therefore seen to be equivalent to a physical jukebox, Cohen teaches the updating of an inventory of digital disks for the benefit of keeping the inventory current.

Art Unit: 3629

Verdun and Tashiro et al each teach display of graphics when the system is not in use for the benefit of attracting customers.

Tashiro et al teaches an digital computer based electronic entertainment device that accepts coins and displays graphics when the device is not in use for the benefit of enticing passers by to stop and use the device.

Verdun teaches an analog electronic entertainment device using video cassettes and a graphics generator, but does not teach digital, it is not relied upon for a digital teaching. Cohen teaches that data of any time may be stored digitally. The leap from analog to digital is seen to be a natural progression of the art for the benefit of better audio and video playback.

6. Applicant's previous challenge to the Official Notice rejections of the previous action do not constitute a proper challenge. Applicant has not specifically pointed out supposed errors in the examiner's action or stated why the noticed features are not common knowledge or well known. The rejection is maintained and the Official Notice is taken to be admitted prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3629

7. Claims 16-17, 20, 22-23, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castille (5,497,502) in view of Cohen (4,949,187) further in view of Verdun (4,667,802) or Tashiro (4,958,835).

As per Claim 16.

Castille ('502) discloses:

- a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;

- a data storage unit for storing, see column 5, lines 28-29, images and associated digital song data, see column 1, lines 17-29,

- a display for showing, to a prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);

- selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys, see column 5, lines 1-25 and figure 1 (15);

- at least one audio speaker, see figure 1 (17);

- a processor connected to a memory, the memory including a decompression algorithm for decompressing compressed digital song data, see column 5, lines 6-10;

- causing the processor, in response to the signal output, to access and process compressed digital song data received from the data storage unit so that the accessed compressed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;

- causing the processor to decompress the accessed compressed digital song data and send the decompressed digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor and the digital to analog converter, see column 5, lines 6-10; and

Castille ('502) discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit.

Cohen ('187) teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1-6.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an updated library of songs stored in the computer jukebox.

Castille ('502) does not disclose a money intake device or a user attract mode wherein song associated images are shown.

Art Unit: 3629

Verdun ('802) and Tashiro et al ('835) teaches a money intake device, see figure 1 (32) and displaying selected graphics when no video selection is playing, see column 1, lines 47-50 of Verdun and figure 5, column 8, lines 31-54 of Tashiro et al for the benefit of making money from the use of the device and of enticing passers by to use the machine.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a money intake device for the benefit of making money from the device and the display of song associated images as taught by Verdun and Tashiro et al to attract users to the device.

As per Claim 17.

Castille ('502) does not specifically disclose:

instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting song usage data under the control of the processor.

Cohen ('187) teaches instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, see column 5, lines 2-7, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting song usage data under the control of the processor, see column 4, lines 26-29 for the benefit of providing users with convenient access to videos and ensure proper royalty payments.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the updated list of songs and store song usage data as taught by Cohen ('187) for the benefit of providing users with convenient access to videos and ensure proper royalty payments.

As per Claim 20.

Castille ('502) further discloses communication interface is telecommunication and further the storage of file identity data, see column 4, line 62 – column 5, line 29.

As per Claim 22.

Castille ('502) discloses:

a plurality of computer jukeboxes, capable of playing songs selected by users of the jukebox from a library of songs that have been digitally compressed and stored in the computer jukebox, see figure 1 (15) and column 4, lines 1-11;

a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;

a data storage unit for storing, see column 5, lines 28-29;

a display for showing, to a prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);

Art Unit: 3629

selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys; see column 5, lines 1-25 and figure 1 (15);

at least one audio speaker, see figure 1 (17);

a processor connected to a memory, the memory including a decompression algorithm for decompressing compressed digital song data, see column 5, lines 6-10;

a digital to analog converter coupled between the processor and the audio speaker to convert digital song data to an analog signal coupled to the speaker, see figure 1 (47);

causing the processor, in response to the signal output, to access and process compressed digital song data received from the data storage unit so that the accessed compressed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;

causing the processor to decompress the accessed compressed digital song data and send the decompressed digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor and the digital to analog converter, see column 5, lines 6-10; and

Castille ('502) discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit and a management station for updating the library of songs in each of the plurality of jukeboxes.

Cohen ('187) teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1-6, from a management station, see figure 4 (36) with communication interface (58), processor (36), storing digital song data (12, 14, 16, 18, 20, 22, 24, 26), data compressor (58) and transmitter (58) and column 1, lines 46-61.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox from a management station, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an updated library of songs stored in the computer jukebox.

Verdun ('802) and Tashiro et al ('835) teaches a money intake device, see figure 1 (32) of Verdun and figure 5 of Tashiro et al for the benefit of making money from the use of the device.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a money intake device for the benefit of making money from the device.

As per Claims 23.

Castille ('502) further discloses bi-directional communications, see figure 1 (2).

Art Unit: 3629

As per Claims 25.

Castille ('502) does not specifically disclose the display of the updated list.

Cohen ('187) teaches instructions causing the processor to display the updated library of songs, see column 5, lines 2-7 for the benefit of providing users with convenient access to videos.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the updated list of songs as taught by Cohen ('187) for the benefit of providing users with convenient access to videos.

As per Claims 26.

Castille ('502) does not specifically disclose the storage of usage data.

Cohen ('187) teaches instructions causing the processor to store usage data, see column 4, lines 26-29 for the benefit of ensuring proper royalty payments.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to store usage data as taught by Cohen ('187) for the benefit of ensuring proper royalty payments.

As per Claim 27.

Castille ('502) discloses:

- a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;

- a data storage unit for storing, see column 5, lines 28-29;

- a display for showing, to a prospective user, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);

- a processor and a memory, the memory including a decompression algorithm for decompressing compressed digital song data, see column 5, lines 6-10; and instructions:

- causing the processor, in response to the signal output, to access and process compressed digital song data received from the data storage unit so that the accessed compressed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;

- causing the processor to decompress the accessed compressed digital song data and send the decompressed digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor, see column 5, lines 6-10; and

Castille ('502) discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit and a management station for updating the library of songs in each of the plurality of jukeboxes.

Cohen ('187) teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1-6, from a management station, see figure 4

Art Unit: 3629

(36) with communication interface (58), processor (36), storing digital song data (12, 14, 16, 18, 20, 22, 24, 26), data compressor (58) and transmitter (58) and column 1, lines 46-61.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox from a management station, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an updated library of songs stored in the computer jukebox.

Castille ('502) does not disclose a money intake device.

Verdun ('802) and Tashiro et al ('835) teaches a money intake device, see figure 1 (32) of Verdun and figure 5 of Tashiro et al for the benefit of making money from the use of the device.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a money intake device for the benefit of making money from the device.

8. Claims 21, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castille (5,497,502) in view of Cohen (4,949,187) in view of Verdun ('802) or Tashiro et al ('835) in view of Official Notice.

As per Claim 21.

Castille ('502) does not specifically disclose the display is at least 14 inches in diagonal measure.

Official Notice is taken that computer monitors of varying sizes are well known in the computer arts as a matter of user choice.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to utilize a display of at least 14 inches in diagonal measure for reasons of user choice.

As per Claim 24.

Castille ('502) further discloses communications link, see figure 1 (2).

Castille ('502) does not specifically disclose the management station is portable.

Official Notice is taken that it is well known to make portable as a design choice. This limitation is seen to be will not distinguish the invention from the prior art in terms of patentability, see In re Lindberg, 93 USPQ 23, 25; 194 F2d 732 (CCPA 1952).

Therefore it would have been obvious to one of ordinary skill at the time the invention was made to make the management station portable as a design choice.

Art Unit: 3629

9. Claims 16-17, 20, 22, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over William (GB 2 193 420) in view of Audiocomp.

As per Claim 16.

William ('420) discloses:

- a money intake device, see page 1, lines 68-69;
- a communications interface for receiving song data, see page 1, lines 105-106;
- a data storage unit, see page 1, lines 65-67;
- a display for showing song data, see page 1, lines 54-63;
- selection keys, see page 1, line 70;
- at least one audio speaker, see page 1, line 108;
- a processor, a memory connected with a memory, see page 1, lines 104-107;
- causing the processor, in responsive to the selection to access and play the selected song, see page 1, lines 38-39;
- causing the processor to update the library of songs stored in the jukebox, see page 1, lines 87-99.

William does not disclose the digital files are compressed.

Audiocomp teaches digital compression technology for storing and transmitting high quality audio with less than one tenth the bits of the standard digitization as a technology well suited to applications where low cost playback is essential.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use the Audiocomp compression technology in the invention of William because of its suitability for applications where low cost playback is essential.

As per Claim 17.

William ('420) further discloses storing song usage data, see page 2, lines 19-24.

As per Claim 20.

William ('420) further discloses the communication interface is a modem, see page 1, line 49-53 and the data storage stores compress song data, see page 1, lines 64-67.

As per Claim 22.

William ('420) discloses:

William ('420) discloses:

- a money intake device, see page 1, lines 68-69;
- a communications interface for receiving song data, see page 1, lines 105-106;
- a data storage unit, see page 1, lines 65-67;
- a display for showing song data, see page 1, lines 54-63;
- selection keys, see page 1, line 70;
- at least one audio speaker, see page 1, line 108;
- a processor, a memory connected with a memory, see page 1, lines 104-107;

Art Unit: 3629

causing the processor, in responsive to the selection to access and play the selected song, see page 1, lines 38-39;

causing the processor to update the library of songs stored in the jukebox, see page 1, lines 87-99.

a management station, see page 1, lines 71-103;

a communication interface see page 1, lines 90-103;

a management station processor connected to a management station memory, see page 1, lines 90-98;

causing the management station processor to store digital song data and send song data to update the library of songs in the jukebox, see page 1, lines 77-113.

William does not disclose the a decompression algorithm.

Audiocomp teaches digital compression technology for storing and transmitting high quality audio with less than one tenth the bits of the standard digitization as a technology well suited to applications where low cost playback is essential.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use the Audiocomp compression technology in the invention of William because of its suitability for applications where low cost playback is essential.

As per Claim 23.

William ('420) further discloses the management station is remote from the jukeboxes and the communication is bi-directional, see figure 1 (10 management station, 11 jukebox, 12 bi-directional communication line)

As per Claim 25.

William ('420) further discloses causing the processor to display the updated list of songs, see page 2, lines 1-18.

As per Claim 26.

William ('420) further discloses storing song usage data, see page 2, lines 19-24.

As per Claim 27.

William ('420) discloses:

William ('420) discloses:

a money intake device, see page 1, lines 68-69;

a communications interface for receiving song data, see page 1, lines 105-106;

a data storage unit, see page 1, lines 65-67;

a display for showing song data, see page 1, lines 54-63;

selection keys, see page 1, line 70;

at least one audio speaker, see page 1, line 108;

a processor, a memory connected with a memory, see page 1, lines 104-107;

causing the processor, in responsive to the selection to access and play the selected song, see page 1, lines 38-39;

Art Unit: 3629

causing the processor to update the library of songs stored in the jukebox, see page 1, lines 87-99.

William does not disclose the digital files are compressed.

Audiocomp teaches digital compression technology for storing and transmitting high quality audio with less than one tenth the bits of the standard digitization as a technology well suited to applications where low cost playback is essential.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use the Audiocomp compression technology in the invention of William because of its suitability for applications where low cost playback is essential.

10. Claims 21, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over William (GB 2 193 420) in view of Official Notice.

As per Claim 21.

William ('420) does not specifically disclose the display is at least 14 inches in diagonal measure.

William teaches that the Video Display Unit can be of any convenient size, see page 1, line 114.

Official Notice is taken that computer monitors of varying sizes are well known in the computer arts as a matter of user choice.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to utilize a display of at least 14 inches in diagonal measure for reasons of user choice.

As per Claim 24.

William ('420) further discloses the communication is a direct communication link interface, see page 1, line 45-48, but does not disclose the management station is portable.

Official notice is taken that in view of In re Lindberg, 93 USPT 23, 26; 194 F2nd 732 (CCPA 1952), to make portable is obvious.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to make the management station portable for the convenience of loading the jukeboxes from any site with a telephone line.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 746-5529 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Thomas A. Dixon
Examiner
Art Unit 3629

August 1, 2003